

## **REMARKS**

The issues outstanding in the Office Action mailed March 11, 2003, are the requirement for restriction and the rejections under 35 U.S.C. §101, §112 and §102, as well as the objection to the claims under 37 C.F.R. §1.75(c). Reconsideration of each of these issues, in view of the following discussion is respectfully requested.

### **Requirement for Restriction**

Applicants hereby affirm the election of Group I, claims 6-9, 21 and 26-35. However, it is submitted that the characterization of this group, at page 2 of the Office Action, is not entirely accurate. Specifically, in part II of the Office Action at page 2, Group I is indicated as being "drawn to compounds of claim 35." In fact, claim 35 is drawn to a method for the synthesis of a compound according to claim 31. The elected group was drawn to both compounds (see claim 31) and methods for making such compounds, as well as methods of using compounds. Subsequent to the present amendment, the elected group is drawn to methods, for example, methods of a scope of former claim 35, and to methods including uses. In any event, to the extent that any subsequent Office Action confirms that the elected group contains the methods, and those methods are now currently in active prosecution, Applicants' former traverse of the restriction is withdrawn.

### **Rejection Under 35 U.S.C. §101**

The present claims have been amended in order to cast them as method claims, and to bring them into conformance with U.S. usage. Thus, it is submitted that the rejection under 35 U.S.C. §101 is moot, and withdrawal thereof is respectfully requested.

### **Rejections Under 35 U.S.C. §112**

Claims 6-9 and 21 have been rejected under 35 U.S.C. §112, second paragraph. Reconsideration of this rejection is respectfully requested.

At page 4 of the Office Action, it is argued that "claims 6-9" recite a presulphurated derivative without antecedent basis. In fact, it is believed that this rejection pertains to step (g) in claim 6, and does not pertain to claims 7-9. In any event, an appropriate amendment has been made,

and withdrawal of this portion of the rejection is respectfully requested. Moreover, cancellation of claim 21 renders this portion of the rejection moot as well. Withdrawal of the rejection is respectfully requested.

### **Objection to Claims**

At page 5 of the Office Action, claims 7-9 and 21 have been objected to under 37 C.F.R. §1.75(c) as being of improper dependent form. Reconsideration of this objection is respectfully requested.

With respect to references in claim 6 to the Figures, appropriate amendment has been made, and withdrawal of this portion of the rejection is respectfully requested. With respect to the dependencies of claims 7-9 and 21 from later occurring claims, it is submitted that a careful reading of 37 C.F.R. §1.75(c) does not prohibit such a situation. Subsection (g) of the rule states that the "least restrictive claim should be presented as claim 1, and all dependent claims should be grouped together with the claim or claims to which they refer to the extent practicable." At the outset, it is apparent that this portion of the rule is not mandatory, inasmuch as it states that the claim "should" be presented in such a manner, and not that it "must." Moreover, the section of the rule states that this practice should be performed "to the extent practicable." In the present situation, where a claim numbered 1 has been presented and discarded, of course, the rule cannot be complied with in its entirety. Moreover, it is submitted that it is not practicable to thoroughly rewrite the claims at this point for purposes of economy. It is gently suggested that the present technique of amendment of claims, and adjustment of dependencies of earlier dependent claims to depend upon newly added but later independent claims, in fact reduces the burden on the Examiner. If Applicants cancel all existing claims and rewrite them, the examiner would have to first correlate an entirely new schedule of claims with the relevant claims which existed previously, and then compare the claims word for word in order to determine what amendments have been made. If, however, the Examiner prefers to perform this task, the Applicants would be happy to cancel all existing claims and replace them with a newly rewritten claim schedule.

### **Rejection Under 35 U.S.C. §102**

All pending claims have been rejected under 35 U.S.C. §102(b) over Koch '908. Reconsideration of this rejection is respectfully requested.

As noted above, in connection with the restriction requirement, methods of preparing of formula I were also claimed in the claims of Group I. These method claims, claims 35 and 6, were argued to be anticipated by the patent at col. 11, lines 28-53. See item (b) at page 5 of the Office Action. In fact, this is respectfully submitted not to be the case. The present claims are directed to a method for obtaining  $^{18}\text{F}$ -labeled halogenated nitroaromatic compounds. Such method involves coupling 2-(2-nitro-imidazole-1-yl) acetic acid with a  $^{18}\text{F}$ -labeled perfluoroalkyl amine derivative. See claim 31. By contrast, to the extent that patentees disclose preparation of perfluorinated nitroaromatic compounds, halogenated 2-nitro-imidazole derivatives are prepared by reacting 2-nitro-imidazole acid derivatives with a halogenated alkyl amine by nucleophilic substitution. The product is a halogenated nitro-imidazole acetamide. Importantly, patentees do not disclose preparation of halogenated nitro aromatic compounds that are  $^{18}\text{F}$ -labeled, in this portion of the patent. Indeed, the only disclosure of such compounds is that at col. 11, lines 30-43, where it is disclosed that "rapid addition of the  $\text{F}^{18}$  moiety followed by immediate purification and use" is desirable. Thus, as is conventional in the art, patentees simply disclose  $^{18}\text{F}$ -labelling of halogenated nitro-aromatic compounds after those compounds are prepared. This clearly does not anticipate, much less render obvious, a process where compounds are prepared *per se* from  $\text{F}^{18}$ -labeled precursors.

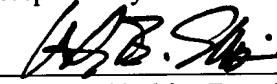
With respect to the present usage claims contained in the elected group, it can be seen that patentees also do not disclose or suggest the preparation of compounds in such a manner followed by the various biological uses claimed. Thus, these claims are also neither anticipated nor suggested by the reference.

In conclusion, it is submitted that the claimed method is neither anticipated nor obvious over the reference and withdrawal of the rejection is respectfully requested.

The claims in the application are submitted to be in condition for allowance. However, should the Examiner have any questions or comments, she is cordially invited to telephone the undersigned at the number below.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

  
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Attorney Docket No.: DCLERC-1

Date: June 11, 2003

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